

13281 U.S. PTO
010904

ATTORNEY DOCKET NO. 046124-5005-US03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

PRIOR APPLICATION:

Examiner: Slobodyansky
Group Art Unit: 1652

17548 U.S. PTO
10/753405
010904

Sir:

TRANSMITTAL OF FILING UNDER 37 C.F.R. § 1.60

This is a request for filing a

☒ Continuation ☐ Divisional

application under 37 C.F.R. § 1.60, of pending prior application, application
no. **09/852,000**, filed on May 10, 2001
of : **OSUMI ET AL**

for: GREEN FLUORESCENT PROTEINS AND BLUE FLUORESCENT PROTEINS

1. Copy of Prior Application as Filed Which is Attached

☒ I hereby verify that the attached papers are a true copy of the above-identified
prior application, including the oath or declaration, as originally filed (37 C.F.R.
§ 1.60).

The copy of the papers of the prior application as filed which are attached are as follows:

45 pages of specification, including
 2 pages of claims
 1 page of abstract
7 sheets of drawings
3 pages of declaration and power of attorney

2. Amendments

☐ Cancel in this application original claims before calculating the filing fee.
[At least one original claim must be retained for filing purposes.]

☐ A preliminary amendment is enclosed (Claims added by this amendment have been properly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

3. PTO-1449 is submitted herewith.

4. Priority - 35 U.S.C. § 119

☐ The certified copy is enclosed.

☒ Priority of Application No. 026418/1998 filed on January 23, 1998 in Japan is claimed under 35 U.S.C. § 119.

☒ The certified copy filed in the parent U.S. Appln. No. 09/121,539 on October 28, 1998 and a certified translation thereof was filed on November 30, 1998.

☐ The certified copy will follow.

5. Relate Back - 35 U.S.C. § 120

☒ Amend the specification by inserting before the first line the sentence:

“This is a ☒ continuation ☐ divisional
of copending application

☒ Application Number 09/852,000 filed on May 10, 2001; which is a divisional of Application No. 09/615,655, filed July 13, 2000, which is a continuation of Application No. 09/121,539, filed July 24, 1998, now U.S. Patent No. 6,194,548, which claims priority to Japanese Patent Application No. 10-26418, filed January 23, 1998. The disclosures of each of the foregoing applications are incorporated herein by reference.

6. Inventorship Statement

a. With respect to the prior copending U.S. application from which this application claims benefit under 35 U.S.C. § 120 the inventor in this application is:

☒ the same

☐ less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:

☐ less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:

b. The inventorship for all the claims in this application are

☒ the same

☐ not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted.

7. Assignment

☒ The prior application is assigned of record to Takashi Osumi recorded on October 20, 1998 at Reel 9522, Frame 0170. A copy of the Notice of Recordation of Assignment Document is enclosed.

☐ An assignment of the invention to _____ is attached.

A separate ☐ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ☐ FORM PTO 1595 is also attached.

8. Fee Calculation - 37 C.F.R § 1.16

CLAIMS FOR FEE CALCULATION				
	Number Filed	Number Extra	at Rate of	Basic Fee \$770
Total Claims (37 CFR § 1.16(c))	14 - 20 =	0	\$18.00 each =	+ \$ 0
Independent Claims (37 CFR § 1.16(b))	7 - 3 =	4	\$ 86.00 each =	+ \$344
Multiple dependent claim(s), if any (37 CFR § 1.16(d))			\$290.00	+ \$0
SUB-TOTAL =				\$1,114.00
Reduction by ½ for filing by a small entity				- \$0
TOTAL FILING FEE =				\$1,114.00

☐ Fee for extra claims is not being paid at this time. (37 CFR § 1.16(d)).

9. Small Entity Status

☐ A verified statement claiming small entity status
☐ is enclosed or ☐ is on file in the prior application and such status is still
proper and desired (37 C.F.R. § 1.28(a))

10. Fee Payment

☐ Not Enclosed.

**NO FEE IS BEING PAID BY CHECK OR DEPOSIT ACCOUNT
AT THIS TIME.**

This application is being filed under the provisions of 37 C.F.R. § 1.53(d).
Applicant(s) await notification from the Patent and Trademark Office of the time
set for filing the Declaration and paying the filing fees.

11. Fee Payment (Continued)

☒ **DEPOSIT ACCOUNT NO. 50-0310.**

<input checked="" type="checkbox"/>	basic filing fee of	\$1,114.00
<input type="checkbox"/>	assignment recording fee of	\$
<input type="checkbox"/>	processing and retention fee of	\$

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby
authorized by this paper to charge any additional fees during the entire pendency

of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, or credit any overpayment to Deposit Account 50-0310.

12. ☒ The power of attorney in the prior application is to at least one of the registered practitioners of Morgan, Lewis & Bockius LLP included in the Customer Number provided below to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, and all correspondence shall be addressed to that Customer Number.

☒ The power appears in the original declaration of the prior application.

☐ Since the power does not appear in the original declaration, a copy of the power in the prior application is enclosed.

13. ☒ Please address all correspondence to:

CUSTOMER NUMBER 009629
Morgan, Lewis & Bockius LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

14. ☐ Recognize as associate attorney _____.
(name, address, and registration no.)

15. Maintenance of Copendency of Prior Application

☒ A petition and fee has been filed to extend the term in the pending prior application for the purpose of maintaining copendency between the prior application and the present application.

☒ A copy of the petition for extension of time in the prior application is attached.

16. [] PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this application, including any extension in the prior application, application no. _____, filed _____, for the purpose of maintaining copendency between the prior application and the present application, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to Deposit Account No. 50-0310. A duplicate copy of this paper is enclosed for use in charging the deposit account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:



Bonnie Weiss McLeod

Reg. No. 43,255

Dated: January 9, 2004

CUSTOMER NO. 09629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

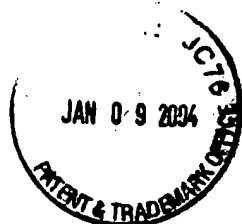
Washington, D.C. 20004

202-739-3000

Direct: 202-739-6150

COPY

Attorney Docket No. 046124-5005-US02



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Takashi OSUMI et al.

Appln. No. 09/852,000

Group Art Unit: 1652

Filed: May 10, 2001

Examiner: Slobodyansky

For: GREEN FLUORESCENT PROTEINS
AND BLUE FLUORESCENT
PROTEINS

PETITION FOR EXTENSION OF TIME FOR COPENDENCY

Commissioner of Patents
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2011 South Clark Place
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Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Applicants hereby petition to extend the life of this application to and through at least January 9, 2004 so as to copend with a continuing application.

The original due date for response to the outstanding Office Action in the subject application was October 9, 2003.

<u>Total Months Requested</u>	<u>Fee for Extension</u>	<u>[Fee for Small Entity]</u>
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 420.00	\$ 210.00
<input checked="" type="checkbox"/> three months	\$ 950.00	\$ 475.00
<input type="checkbox"/> four months	\$ 1,480.00	\$ 740.00

The requisite extension fee in the amount of **\$950.00** is to be charged to Deposit Account 50-0310.

Please charge any missing or inadequate fee re this Petition to Deposit Account No. 50-0310 for which purpose a duplicate copy of this sheet is attached.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By:



Bonnie Weiss McLeod
Reg. No. 43,255

Dated: January 9, 2004

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